

### **REMARKS**

Claims 1-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (U.S. Patent No. 5,902,667) in view of Sloom (U.S. Patent No. 6,178,680) and Amburgey (U.S. Patent No. 5,974,997). Applicant respectfully asks the Examiner to reconsider this rejection in view of the below Remarks.

The present invention is directed to a system for retaining and displaying a piece of material, and more specifically to a piece of fabric which is encapsulated with a specially adapted surround so that the fabric may be adhered to another member and be retained thereon without being damaged, such as by fraying. The system of the present invention is the end product of a novel manufacturing method which is the subject of issued U.S. Patent No. 6,752,892.

The system of the present invention includes, and all claims of the present application require, among other elements, the following: (i) a piece of material which is attached to (ii) an intermediate fixation system which itself is attached to (iii) a lower layer having an outer periphery, the lower layer being sized such that the outer periphery thereof extends beyond the outer periphery of the piece of material, and (iv) an upper layer having an outer periphery sized such that the outer periphery of the upper layer extends beyond the outer periphery of the piece of material, and is sealed to the upper surface of the lower layer.

Applicant respectfully submits that none of the prior art references discloses, teaches or suggests in any way, either alone or in combination, an intermediate fixation system which is attached on one side to a piece of material and on another side to a lower layer.

First, Applicant respectfully disagrees with the Examiner's equating of the upper thermoplastic layer 15 of Stahl with the claimed intermediate fixation system. As would be recognized by one skilled in the art, and as defined in *The American Heritage® Dictionary of the English Language, Fourth Edition*, the term "intermediate" means "[l]ying or occurring between two extremes or in a middle position or state." This is consistent with Applicants use of the term, as the intermediate fixation system is disposed between and joins the piece of material and the lower layer.

In Stahl, however, the "upper thermoplastic layer 15" is just that -- an upper layer. The layer itself is an extreme (i.e., it is an uppermost layer). The layer is not "intermediate" to anything. As such, Applicant respectfully submits that Stahl does not disclose, teach or suggest in any way an "intermediate fixation system" as required by all claims.

Moreover, even if the upper thermoplastic layer 15 of Stahl could be considered as equivalent to the intermediate fixation system of the present invention, Stahl does not disclose, teach or suggest in any way a piece of material attached to the upper surface of the upper thermoplastic layer. The Examiner expressly recognizes this in the last paragraph of page 2 of the Office Action. However, the Examiner contends that it would have been obvious to modify Stahl to include a material layer attached on top of the upper thermoplastic layer 15 in view of the teachings of Slood. Applicant respectfully disagrees.

The entire Stahl reference is concerned with an impressed emblem (i.e., an emblem having marks formed by pressure in the upper thermoplastic layer 15) and a method for creating such an impressed emblem. As such, it is absolutely

necessary for the teachings of Stahl to have any meaning that the uppermost layer be thermoplastic layer 15. Not only is there no motivation to provide an extra layer of material on top of thermoplastic layer 15, but doing so would be contrary to the entire purpose of the Stahl reference in that the impressed upper thermoplastic layer 15 would no longer be visible.

Moreover, the only motivation the Examiner has cited for piecing together the three cited references to arrive at the claimed invention is "in order to provide an aesthetically pleasing display for apparel such as T-shirts, sweaters, hats, shorts, accessories, water proof materials, and the like." However, Applicant respectfully submits that these goals could be achieved in numerous ways other than by the claimed invention, and that the Examiner has failed to cite motivation for one skilled in the art to arrive at the very precise structure required by all claims of the present invention as opposed to any of the other possible configurations.

Applicant further submits that the Examiner could not have cited such motivation, because no such motivation existed prior to Applicant's invention of the system and method which is the subject of the present application. More specifically, Applicant submits that the reason for the precise configuration claimed is that the claimed configuration is the end product of the method which has already been recognized as being novel through issuance of parent U.S. Patent Application No. 6,752,892. Applicant submits that there is simply no other reason to create the system claimed (as opposed to simply practicing one of the prior art systems), and one skilled in the art would not have any motivation, absent the benefits accorded by the novel method of creation (which of course was not known to those skilled in the art at the time of invention by Applicant), to modify the prior art to arrive at the claimed system.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1-10, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Todd M. Oberdick", is written over a horizontal line.

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**Amendments to the Drawings:**

No amendments are made to the Drawings herein.